

**REMARKS**

Reconsideration of this application is respectfully requested.

Claims 17-22, 25, and 27-40 are pending in this application with claims 17-22 allowed.

Claims 25, 29, and 32 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to the skilled artisan that the inventors had possession of the claimed invention at the time the application was filed. The Office bases the rejection on an alleged lack of written description of sequences that hybridize to the DNA of claim 17.

Applicants traverse the rejection. Claims 25, 29, and 32 are directed to ***generic methods*** for preparing and detecting the presence of HIV-1 RNA. These methods do not require knowledge of the sequence of the HIV-1 virus that is prepared and detected. Thus, applicants need not provide the sequence of all HIV-1 viruses to describe a generic method that will work with all of these viruses. Moreover, the Office has set forth no reasons to doubt that the claimed methods will work regardless of the sequence of the HIV-1 virus that is prepared and detected. Accordingly, applicants respectfully request withdrawal of the rejection.

Furthermore, the Office alleged that: “[c]laims 25, 29, and 32 encompass a genus of nucleic acids which are different from those disclosed in the specification *due to the use of hybridization language*.” (Office Action at 3, emphasis added.) The Office has overlooked that claims 29 and 32 do not contain “*hybridization language*.” Thus, the

basis for the Office's rejection of claims 29 and 32 is in error, and applicants respectfully request withdrawal of the rejection.

Claims 35-40 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to the skilled artisan that the inventors had possession of the claimed invention at the time the application was filed. The Office contends that the specification does not support the limitation "CTCAATAAGCTTGCCTTG."

Applicants traverse the rejection. The limitation "CTCAATAAGCTTGCCTTG" can be found on page 13, line 13, of the specification. Thus, the basis for the Office's rejection of claims 35-40 is in error, and applicants respectfully request withdrawal of the rejection.

Claims 25, 29, and 32 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-6 of U.S. Patent No. 6,627,395. Solely to expedite prosecution of this application and not in acquiescence to this rejection, applicants agree to file a Terminal Disclaimer once applicants have determined the correct inventors and ownership of this application.

Claims 27, 28, 30, 31, 33, and 34 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Applicants traverse the objection. As discussed above, the "base" claims 25, 29, and 32 are allowable. Accordingly, this objection is moot.

Applicants respectfully submit that this application is in condition for allowance. In the event that the Examiner disagrees, he is invited to call the undersigned to discuss any outstanding issues remaining in this application in order to expedite prosecution.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: October 25, 2005

By: \_\_\_\_\_

  
Salvatore J. Arrigo  
Registration No. 46,063  
Telephone: 202-408-4160  
Facsimile: 202-408-4400  
E-mail: arrigos@finnegan.com